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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/680,847	10/06/2003	Scott A. Lerner	IL-11180	5385

7590 03/24/2005

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EXAMINER

EVANS, FANNIE L

ART UNIT PAPER NUMBER

2877

DATE MAILED: 03/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

15

Office Action Summary	Application No. 10/680,847	Applicant(s) LERNER, SCOTT A.	
	Examiner F. L. Evans	Art Unit 2877	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3 is/are rejected.
- 7) ☒ Claim(s) 2 and 4-14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The Information Disclosure Statement

The prior art cited in the information disclosure statement filed on October 6, 2003 has been considered.

The Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. The specification is silent with respect to the lens being germanium (claim 2), the refractive surface of the immersed diffraction grating being an anamorphic asphere (claim 9), the immersed diffraction grating having a spherical or aspheric grating surface (claim 10), the lens having an anamorphic asphere surface (claim 11), the immersed grating consisting of 2 or more prisms (claims 12), the lens consisting of two or more coaxial lenses (claim 13) and the lens consisting of two or more non-coaxial lenses. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the specification is required. No new matter should be introduced.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 and 3 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over dependent claim 2 of copending Application No. 10/658,141. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 2 of the copending application anticipates claims 1 and 3 of this application.

Claim 2 of the copending application set forth a compact imaging spectrometer apparatus (line 1 of claim 1 of the copending application), comprising: an entrance slit for directing light (line 2 of claim 1 of the copending application), lens means for receiving said light, refracting said light, and focusing said light (line 3 of claim 1 of the copending application); an immersed diffraction grating (lines 1 and 2 of claim 2 of the copending application) that receives said light from said lens means and defracts said light, said immersed diffraction grating directing said defracted light back to said lens means (lines 4 and 5 of claim 1 of the copending application); and a detector that receives said light from said lens means (line 6 of the copending application). The immersed diffraction grating has rulings in a germanium surface (lines 1 and 2 of the copending application).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Allowable Subject Matter

Claims 2 and 4-14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Art Unit: 2877

As to claim 2, the prior art of record, taken alone or in combination, fails to disclose or render obvious a compact **imaging** spectrometer comprising a germanium lens, in combination with the rest of the limitations of the claim.

As to claim 4, the prior art of record, taken alone or in combination, fails to disclose or render obvious a compact **imaging** spectrometer comprising an immersed diffraction grating with 115 lines/mm, in combination with the rest of the limitations of the claim.

As to claim 5 and 6, the prior art of record, taken alone or in combination, fails to disclose or render obvious a compact **imaging** spectrometer with the components thereof located within an envelope, in combination with the rest of the limitations of the claim.

As to claim 7, the prior art of record, taken alone or in combination, fails to disclose or render obvious a compact **imaging** spectrometer comprising a 2D detector, in combination with the rest of the limitations of the claim.

As to claims 8-10 and 12, the prior art of record, taken alone or in combination, fails to disclose or render obvious a compact **imaging** spectrometer comprising immersed diffraction grating configured as claimed, in combination with the rest of the limitations of the claims.

As to claims 11, 13 and 14, the prior art of record, taken alone or in combination, fails to disclose or render obvious a compact **imaging** spectrometer comprising a lens configured as claimed, in combination with the rest of the limitations of the claims.


Fax/Telephone Numbers

Papers related to this application may be submitted to Technology Center 2800 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The fax number for Technology Center 2800 is (703) 872-9306 for regular and After Final communications.

Art Unit: 2877

Any inquiry concerning this communication or earlier communications from the examiner should be directed to the examiner whose telephone number is (571) 272-2414. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory J. Toatley, Jr., can be reached on (571) 272-2800 ext 77.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



F. L. EVANS
PRIMARY EXAMINER
ART UNIT 2877

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March 18, 2005